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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,610	01/24/2004	Karan Mari Hintze	2401-pa	7265
7590	12/14/2005		EXAMINER REESE, DAVID C	
Dennis A. DeBoo DeBoo & Co. 400 Capitol Mall, Suite 900 Sacramento, CA 95814			ART UNIT 3677	PAPER NUMBER

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,610

Applicant(s)

HINTZE, KARAN MARI

Examiner

David C. Reese

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 12-20 is/are allowed.
6) ☒ Claim(s) 1-11 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 10/15/2005.

Status of Claims

- [1] Claims 1-20 are pending.

Claim Objections

- [2] Claim(s) 19 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 10/15/2005. Accordingly, the objection(s) to the claim(s) 19 have been withdrawn.

An additional claim objection has been found, however, as Claim 5 is objected to because of the following informalities: "the wearer," should be changed to "a wearer". Appropriate correction is required.

Claim Rejections - 35 USC § 112

- [3] Claim 5 recites the limitation "said raceway" in the instant claim and dependent one therefrom. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

- [4] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3677

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[5] Claims 1-11 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Prussian, US-1,864,371, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Prussian teaches of an article of jewelry comprising in combination:

a casing (14) having an encompassing sidewall (22) defining a hollow casing interior (inside 14, 22), said sidewall (22) having a bottom peripheral end (24) defining an open bottom end (26) and an upper peripheral end (16) transitioning into a top (14) with an opening therein (18 in Fig. 2), said top (14) comprised of an interior rim (1, figure next page) surrounding said opening (18 in Fig. 2) and having a bottom rim surface (2, figure next page) leading to said hollow casing interior (inside of 22);

a rotating gem retaining means (32) at least partially received within said hollow casing interior (inside 14, 22) and including an upper portion (30) for securely retaining a gem (28) having a crown visible through said opening of said top of said casing (28),

said rotating gem retaining means (32) further including a lower portion (34) comprised of an elongated member axially extending away from said upper portion of said gem retaining means (32) and terminating into a tapered lower end (bottom of 34, 38);

Art Unit: 3677

a plurality of radially extending protrusions (30, 30') disposed within said hollow casing interior (inside 14, 22) and rotatably coupled to said bottom rim surface (2 , figure next page) of said casing (14) and operatively coupled to said rotating gem retaining means (32); and

a bottom member (36) operatively coupled across said opened bottom end (26) of said casing (14) and having an upper surface with a notch (inside of 36, threads as shown in Fig. 2) formed therein for rotatably receiving said tapered lower end of said elongated member (bottom of 34, 38) therein and for rotatably biasing (when threading in said gem retaining means, the gem will rotate) said plurality of radially extending protrusions (30, 30') with said bottom rim surface (2) of said casing (14) for rotatably setting the gem retaining means (32) and gem (28) for providing gem rotation (via 34 against the inside of 36) visible through said opening in said top of said casing (inside of 14) in response to movement of said rotatable setting device.

Art Unit: 3677



Re: Claim 2, wherein said upper portion of said gem retaining means is comprised of a plurality of prong members (30,30') including at least one pair of substantially diametrically opposed prong members (30,30') having a first prong member substantially diametrically opposed to a second prong member (30,30').

Re: Claim 3, further including a pair of weighted members (30, 32 in Fig. 2) including a first weighted member (30 in Fig. 2) operatively coupled to said first prong member (30' in Fig. 2) and a second weighted member (32 in Fig. 2) operatively coupled to said second prong member (30' in Fig. 2) for defining a pair of substantially diametrically opposed weighted members (30, 32 in Fig. 2).

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: “working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing”.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 4, further including at least one weighted member (30, 32 in Fig. 2) operatively coupled to said upper portion of said gem retaining means (30’).

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: “and working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing”.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 5, wherein said protrusions (30’) are rotatably biased with said raceway (see 112 rejections) during gem rotation (insertion, removal of gem) due to said at least one weighted member (32).

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: “working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing”.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 6, wherein said bottom surface of said rim (2) is recessed upwardly forming a curved protrusion in a top surface (18 in Fig. 2) of said top of said casing (14) which circumscribes said top opening.

Re: Claim 7, wherein said top surface of said top of said casing is decorative (14 in Fig. 1).

Re: Claim 8, wherein said gem retaining means (32) is comprised of a base (bottom of 32, before 34) and a plurality of prong members (30') defining a prong setting, said base defines a central region with a central axis running therethrough (bottom of 32, before 34) and said prong members (30') having spaced apart lower ends integrally formed with said base member (bottom of 32, before 34) and upwardly extending from said base member in a spaced apart relationship with respect to one another and at an angle with respect to the central axis of the base member (Fig. 2) and terminating into radiused upper ends such that said plurality of prong members (30') are arranged about the central axis to correspond with gem shape.

Re: Claim 9, wherein each of said plurality of prong members includes a notch (between 30 and 30' in Fig. 2) located on an interior side of said upper ends of said plurality of prong members (32) for operatively mating with a girdle of the gem (28) for providing secure gem retention.

Re: Claim 10, wherein said elongated member (34) is integrally formed with said base member (top of 34, bottom of 32) and axially extends away from an underside of said base

Art Unit: 3677

member along the central axis and terminates into said tapered lower end (bottom of 34, 38 in Fig. 2).

Re: Claim 11, wherein said bottom member is comprised of an elongated bar member (36) operatively coupled across said opened bottom end of said casing (26) such that light can shine through the pavilion of the gem (28) via the opened bottom end of the casing (inside of 14) for dispersion viewing through the crown and wherein said elongated bar member (36) includes said notch (inside of 36, threads) formed therein for rotatably receiving said tapered tip (bottom of 34, 38) of said elongated member (34) therein and for rotatably biasing said plurality of protrusions (30') against said bottom surface of said rim (18) of said casing (14) for providing gem rotation in response to movement of said jewelry article by a wearer (insertion, removal of gem).

Response to Arguments

[6] Applicant's amendment filed 10/15/2005 regarding rejections of claims 12-20 under 35 U.S.C. 102 have been fully considered. Due to the amendment to the claims, the prior art fails to further anticipate. Accordingly, the Examiner has withdrawn all previous rejections with regard to the above claims to Prussian, US-1,864,371.

[7] Applicant's amendments and arguments filed 10/15/2005 regarding rejections of claims 1-11 under 35 U.S.C. 102 have been fully considered but they are not persuasive. The current state of the amended claims 1-11 still read upon the prior art of Prussian for the reasons listed above in this instant office action.

Allowable Subject Matter

[8] Claims 12-20 are allowed.

[9] As for Claims 12-18, the prior art, incorporating other corresponding limitations as set forth in the instant claim, does not teach of cylindrical protrusions attached to said prongs; the protrusions in conjunction with said prongs rotatably coupled to said bottom rim surface. Claims 13-18 are dependent upon independent claim 12.

As for independent claim 19, the prior art, incorporating other corresponding limitations as set forth in the instant claim, does not teach of protrusions coupled to each prong at a marked location; each coupled protrusion to said prong being rotatably coupled to the bottom rim surface. Claim 20 is dependent upon independent claim 19.

Art Unit: 3677

Conclusion

[10] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272- 7082. The examiner can normally be reached on 7:30 am - 6:00 pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. **Please also note the change in the fax phone number to (571) 273-8300 for the organization where this application or proceeding is assigned.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Assistant Examiner
Art Unit 3677

DCR


ROBERT J. SANDY
PRIMARY EXAMINER